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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,990	01/15/2000	Peter Heitkamper	Mo-5278/LcA 33,335	7774

7590

11/26/2002

Patent Department
Bayer Corporation
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EXAMINER

GORR, RACHEL F

ART UNIT

PAPER NUMBER

1711

16

DATE MAILED: 11/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/482,990

Applicant(s)

HEITKAMPER ET AL.

Examiner

Rachel Gorr

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-11 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 is confusing because the preceding claim has no antecedent basis for "the prepolymer".

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Windemuth.

Windemuth discloses, in example 3, a prepolymer comprising 79 wt. % polyester diol having a molecular weight of 1800 and about 19 wt. % tetramethyl p-phenylenediisocyanate (durene diisocyanate). The chain extends with water, which would form some cells. The coating of Windemuth is cast onto a surface. The polyurethane composition would be the same as one prepared with a different catalyst because catalysts don't change the polymer, only speed the reaction time. When a reference discloses all the limitations of a claim except a property, and the examiner

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can't determine if the reference inherently possesses the property, the burden of proof is shifted to the applicant (*In re Fitzgerald*, 205 USPQ 594). When a reference appears to be the same as a product set forth in a product-by-process claim, the burden of proof is shifted to the applicant (*In re Marosi*, 218 USPQ 289).

5. Applicant's arguments filed 10-15-02 have been fully considered but they are not persuasive. The applicants argue that Windemuth cures with water vapor, not water. Water vapor is water. The applicants argue that the casting procedure implies a specific procedure. The word casting is frequently used to cast films on surfaces without the specific procedure detailed by the applicants in their arguments. The applicants argue that Windemuth isn't cellular and that the examiner can't assume that the density of Windemuth is the same as the density specified in claim one. The density of claim one for the cellular material overlaps the density of claim 6 for a compact article. A density of 1 g/cc is the density of water and organic polymers have densities similar to this value. Since Windemuth cures with water, it's probable that the coating contains some cells. The applicants argue that different catalysts make polymers of different compositions. In general, catalysts only speed the reaction.

6. Claims 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scott in view of Henn.

See Paper No. 14, paragraphs 6-8.

7. Applicant's arguments filed 10-15-02 have been fully considered but they are not persuasive. The applicants argue that the examiner has no factual basis for assuming the density of Scott's polymer as being the same as specified densities of the

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claims. The polymers of Scott are made from the same ingredients as the applicant's polymers. Therefore, it's difficult to see why the densities would be different. The applicants argue that Henn can't be combined with Scott because Henn is directed to a different polyurethane having a different composition. The examiner asserts that Henn's teachings about polyurethanes made from one-shot methods or prepolymer methods are applicable to any polyurethane composition.

8. Claim 3 is objected to for depending on a rejected claim.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel Gorr whose telephone number is (703) 308-3608. The examiner can normally be reached on Mon., Tues., Thurs., Fri., from 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


RACHEL GORR
PRIMARY EXAMINER